

## II. Nonstatutory Double Patenting Rejections

Claims 1-9, 13-19, and 29-59 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-85, 152, and 153 of U.S. Application No. 09/820,480. See page 4 of the present Office Action.

Applicants were unable to locate or identify such an application and therefore request clarification and/or confirmation of the proper application number of the application to which the Examiner is referring so that they may respond to this rejection.

## III. Rejection under 35 U.S.C. § 103

Claims 1-9, 13-19, and 29-59 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,235,298 ("*Naser*") in view of U.S. Patent No. 5,688,930 ("*Bertho*") for the reasons set forth on pages 5-6 of the present Office Action. Applicants respectfully traverse this rejection.

Two of the basic criteria an Examiner must demonstrate in order to establish a prima facie case of obviousness are (1) that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and (2) that there is a reasonable expectation of success in making the proposed modification. See M.P.E.P. § 2143. Neither of these two criteria has been satisfied with respect to the modifications of *Naser* proposed by the Examiner.

With respect to the first criterion, the Federal Circuit has recently stated that:

[t]he factual inquiry whether to combine references must be thorough

and searching. It **must be based on objective evidence of record....** Thus the Board must not only assure that the requisite findings are made, based on evidence of record, **but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.**

See *In re Lee*, 61 U.S.P.Q.2D (BNA) 1430 (Fed. Cir. 2002) (emphasis added).

Moreover, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01. In the present case, the Examiner has failed to make a factual inquiry based on any objective evidence of record. Such an inquiry would reveal that there would have been no motivation to make the proposed modifications at the time the invention was made.

*Naser* discloses water-in-oil-in-water, "W<sub>1</sub>-O-W<sub>2</sub> emulsions in which the W<sub>1</sub>/O emulsion comprises an internal aqueous phase containing optional benefit agent and an oil phase surrounding it, and, around this is found an external isotropic aqueous phase comprising a surfactant system and specific thickeners." See Abstract. The Examiner admits that *Naser* fails to teach the claimed pentoses." See page 5 of the present Office action.

However, contrary to the Examiner's implication that *Naser* satisfies all elements of the claims except for "the claimed pentoses," substantial picking and choosing from among numerous disclosed optional ingredients would be required in order to arrive at the presently claimed invention. "To establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir,

2000). Even when obviousness is based on a single prior art reference, there must be a such showing. See *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2D (BNA) 1314, 1318 (Fed. Cir. 1996). In the present case, the Examiner has not provided any motivation, suggestion or teaching of the desirability of making the specific combination that was made by Applicants. In contrast, the Examiner merely states that "*Naser* teaches a water-soluble quaternary ammonium hair conditioner such as the claimed Polyquaternium-10." See page 5 of the present Office Action.

*Naser* does not teach or suggest the combination of all elements of the present claims other than "the claimed pentoses" as the Examiner asserts. *Naser* merely discloses numerous optional topically-active compounds, such as (1) hair conditioners, (2) skin conditioners, (3) hair cleansers, (4) skin cleansers, (5) hair fixatives, (6) hair dyes, (7) hair growth promoters, (8) deodorants, (9) skin care compounds, (10) permanent wave compounds, (11) hair relaxers, (12) hair straighteners, (13) antibacterial compounds, (14) antifungal compounds, (15) anti-inflammatory compounds, (16) topical anesthetics, (17) sunscreens and (18) other cosmetic and medicinal topically effective compounds. See col. 5, lines 41-53. Further, *Naser* does not provide the requisite motivation for choosing at least one compound comprising at least two quaternary ammonium groups. See e.g., col. 5, line 66-col. 6, line 26 reciting "[t]he water soluble quaternary ammonium compounds have the general structural formula:" wherein the compound contains one quaternary ammonium group. Further, *Naser* does not exemplify compositions comprising polyquaternium-10 or any other compound comprising at least two quaternary ammonium groups. Thus, one of

ordinary skill in the art would not have been motivated to pick and choose the particular combination of components as presently claimed at least for the reason that *Naser* does not teach or suggest the desirability of doing so.

Further, even if, *arguendo*, one of ordinary skill in the art would have been motivated to pick, choose, and combine specific optional ingredients such as polyquaternium-10 to add to the compositions of *Naser*, one of ordinary skill still would not have been motivated to add the alkyl pentosides of *Bertho* to the modified compositions of *Naser*. For example, *Naser* repeatedly and emphatically states that “[s]election of [the] surfactant system and thickener is critical to the multiple emulsion composition not phase separating.” See e.g., Abstract; see also col. 1, lines 47-50, col. 2, lines 30-31, col. 4, lines 9-10, and Examples. Thus, *Naser* teaches away from one of ordinary skill in the art randomly choosing the surfactant, such as alkyl pentosides of *Bertho*. Moreover, even if one of ordinary skill in the art might have been motivated to try adding the surfactant of *Bertho* to the modified compositions of *Naser*, such motivation is not sufficient to support a rejection under § 103.

Further, for at least this same reason, the Examiner has failed to meet her burden with respect to the second criterion the Examiner must demonstrate in order to establish a *prima facie* case of obviousness - that there is a reasonable expectation of success in the proposed combination. With *Naser*’s warnings regarding criticality of the selection of the surfactant system and thickener in mind and the fact that *Bertho* discloses that its surfactants have a “higher foaming power than that of the surface active agents which are currently most frequently used” at col. 6, lines 49-51, one of

ordinary skill in the art would not have had a reasonable expectation of success in the proposed combination.

Accordingly, for at least the foregoing reasons, Applicants respectfully request the withdrawal of this rejection.

### **III. Information Disclosure Statement**

~~At page 6 of the present Office Action, the Examiner states that items #18 and 19~~ on the Information Disclosure Statement filed May 30, 2001, were not considered because they lack a date. However, Applicants bring to the Examiner's attention the fact that the documents are results from a literature search performed by the Assignee and are compilations of Abstracts. Each Abstract has a date associated with it and this date is printed on the Abstracts themselves.

Accordingly, Applicants respectfully request that the Examiner consider the items #18 and 19 and indicate that she has considered them on the Form PTO 1449.

### **IV. Conclusion**

Applicants respectfully request the reconsideration and the timely allowance of the pending claims.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Please grant any extensions of time required to enter this response and charge  
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P

*Thalia V. De T...*, Reg No. 39,064  
By: *for Anthony C. Tridico*  
Anthony C. Tridico  
Reg. No. 45,958

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408556

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com